

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/621,631	03/26/96	BROWN	P 621.631

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PM82/1106

EXAMINER

MILLER, E

ART UNIT	PAPER NUMBER
3641	34

DATE MAILED:

11/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/621,631	BROWN ET AL.
	Examiner	Art Unit
	Edward A. Miller	3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 August 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 3-22 is/are pending in the application.

4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 3 and 10-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on (originally informal) is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

1. The text of those sections of Title 35, U. S. Code, not included herein can be found in a prior Office action.
2. Claim 10 is rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over each of the Harbuck et al. article and Carlson '970.

In Carlson '970, note "Example E", col. 15-16, where scandium is recovered by extraction with DEHPA and then stripped with 2M NaOH, the scandium extraction being quantitative. This is from the earlier process of "Example B", col. 10, which may be from a sulfuric/boric acid leach, line 42, or via sulfuric acid alone, line 52. In Harbuck et al., pages 109-110, strong sulfuric acid worked well, as did extraction with DEHPA at pages 114-115, and stripping with NaOH on page 116, for example. To the extent necessary, variation of parameters would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person or ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Applicant's arguments are principally that there is no teaching in the references of separating and removing fluorine in the process. While this observation is correct as far as relevant to this rejection, it totally ignores that there is no recitation regarding fluorine in claim 10 at all. To argue a limitation not claimed is unlikely to define over the references. Further, to be so adamant about obtaining a broad claim, which breadth applicants are clearly not entitled to, suggests that there is no basis for reasonable discourse as to any possibilities.

3. Claims 3 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson '970.

Note col. 3, lines 1-30 and col. 5, lines 17-20, e.g., teaching source material. "Example B" in col. 10 further teaches reacting the source material, at lines 51-53, e.g. Eventual recovery of

Art Unit: 3641

scandium, and organo-phosphate extraction is taught in "Example E", in col. 15-16. In any event, variation of the teachings of plural, sequential stages and other parameters would have been obvious, per the case law cited above as to optimizing result effective variables.

Applicants' arguments are not well founded. As to the broader claims, breadth is not per se indefinite, *In re Garner*, 166 USPQ 138,140. However, it does make the claims amenable to rejection over a wider variety of references. It is not clear from the arguments, comparing the recited claim limitations to the teachings of the prior art, what unexpected results or other factors are being relied upon to overcome the prima facie case made. *(Arguedo)* Lack of anticipation does not preclude obviousness.

4. New formal drawings are required. In accordance with recent changes in Office practice, formal drawings are required without regard to allowable subject matter. Corrections as set forth in Paper No. 6, "Notice of Draftsperson's...", Form 948, are required.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached daily, ~~except alternate Fridays~~, from about 9:30 AM to 7 PM.  
*MT-Thur.*

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
November 5, 2001

  
EDWARD A. MILLER  
PRIMARY EXAMINER